

Remarks and Arguments

1. The Specification has been amended to make explicit mention of PID Loop

Controllers, which are clearly "controllers which are commonly used" as stated at the end of the first paragraph on page 6 of the *original* Application. No new matter has been introduced. The amendment does not add new aspects of the Invention, but rather gives further information of the context in which it may be used. The information does not expand the meaning of the claims. Applicant believes that this information is very well known to those skilled in the art

2. Applicant has cancelled the above indicated claims. Applicant has amended the above indicated claims to focus on PID Loop Controllers. There is support in the *original* Specification at the end of the first paragraph on page 6: "controllers which are commonly used". The Specification has been amended above to make this concept more explicit and to give one example. Applicant believes that this term "PID loop controller", or that concept, is not found in any of the patents cited against the claims. Therefore, **all elements and limitations of the claims** rejected under 102 and 103 are **not found** in the cited patents, or in the combinations of patents. Therefore, the rejection of the claims under both 102 and 103 should be withdrawn.

3. In addition to the reasons for withdrawing the 103 rejections set out in Section 2 above, Applicant asserts that the Office Action has **not adequately shown the motivation to combine** the 103 references.

A major new case from the U. S. Court of Appeals for the Federal Circuit (In Re Kahn, 04-1616 (Serial No. 08/773,282, Decided March 22, 2006) has emphasized that to support an obviousness rejection, the Examiner **cannot make broad conclusory statements** that the invention is obvious from cited patents, but **must give reasons** for that statement, and **must give reasons for the existence of a motivation to combine**. The following excerpts from the case contain these points:

"Most inventions arise from a combination of old elements and each element may often be found in the prior art. Id. at 1357. However, mere identification in the prior art of each element is insufficient to defeat the patentability of the combined subject matter as a whole. Id. at 1355, 1357. Rather, to establish a prima facie case of obviousness based on a combination of elements disclosed in the prior art, the Board must articulate the basis on which it concludes that it would have been obvious to make the claimed invention. Id. In practice, this requires that the Board "explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious." Id. at 1357-59. This entails consideration of both the "scope and content of the prior art" and "level of ordinary skill in the pertinent art" aspects of the Graham test.

When the Board does not explain the motivation, or the suggestion or teaching, that would have led the skilled artisan at the time of the invention to the claimed combination as a whole, we infer that the Board used hindsight to conclude that the invention was obvious. Id. at 1358. The "motivation-suggestion-teaching" requirement protects against the entry of hindsight into the obviousness analysis, a

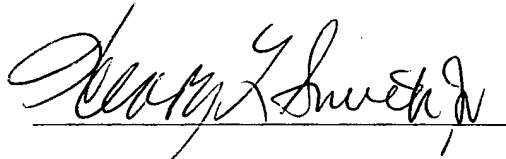
problem which § 103 was meant to confront. ... By requiring the Board to explain the motivation, suggestion, or teaching as part of its prima facie case, the law guards against hindsight in all cases—whether or not the applicant offers evidence on secondary considerations—which advances Congress’s goal of creating a more practical, uniform, and definite test for patentability. ... The motivation-suggestion-teaching test picks up where the analogous art test leaves off and informs the Graham analysis. To reach a non-hindsight driven conclusion as to whether a person having ordinary skill in the art at the time of the invention would have viewed the subject matter as a whole to have been obvious in view of multiple references, the Board must provide some rationale, articulation, or reasoned basis to explain why the conclusion of obviousness is correct. The requirement of such an explanation is consistent with governing obviousness law, see § 103(a); Graham, 383 U.S. at 35; Dann, 425 U.S. at 227-29, and helps ensure predictable patentability determinations.... However, rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. ... Therefore, the “motivation-suggestion-teaching” test asks not merely what the references disclose, but whether a person of ordinary skill in the art, possessed with the understandings and knowledge reflected in the prior art, and motivated by the general problem facing the inventor, would have been led to make the combination recited in the claims.

Therefore, if the Examiner repeats any 103 rejections based on an alleged motivation to combine references, Applicant **request that the required reasons in light of the Kahn case be given.**

Conclusion

Because of the above amendments, and because of the above discussion and arguments, Applicant respectfully submits that the Application, with claims as amended above, is now in condition for allowance, and that action is urgently requested. Enclosed is a check for the fee required by the attached Petition for Extension of Time.

Respectfully Submitted,

A handwritten signature in dark ink, appearing to read "Henry L. Smith, Jr.", written over a horizontal line.

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Signed:

Name: Henry L. Smith, Jr., #31,425 Date: JULY 24, 2006